

**REMARKS**

Claims 1, 3-16 and 18 are pending in this application. Claims 9-16 and 18 stand withdrawn. By this Amendment, claims 9-16 and 18 are amended to depend from claims that are being examined. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration; and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

**I. Withdrawn Claims**

As the withdrawn claims are amended to essentially recite the subject matter as originally filed, and to depend from allowable pending claims, Applicant requests rejoinder and allowance of withdrawn claims 9-16 and 18.

**II. Claim Rejections under 35 U.S.C. §103**

Claims 1, 3, 4 and 6-8 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,171,254 to Sher in view of U.S. Patent No. 6,092,898 to DeJuan, Jr. The rejection is respectfully traversed.

Neither Sher nor DeJuan, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims. For example, the combination of references fails to disclose or suggest a holding apparatus for holding a vitreous body surgical contact lens, comprising an eyelid opener portion that pulls and opens an upper eyelid and a lower eyelid; a holding portion that holds the vitreous body surgical contact lens on an eyeball and a connecting portion connected to the holding portion and the eyelid opener portion so that a position of the holding portion relative to the eyelid opener portion and the eyeball is adjustable, as recited in claim 1.

It is alleged in the Office Action that Sher discloses each and every feature recited in the rejected claims and combines DeJuan only for the alleged teaching that is known to place a surgical lens on the surface of the eye. It is alleged in the Office Action that the speculum 20 of Sher corresponds to the claimed eye opener portions, the fixation ring/fixation portion 60/61 corresponds to the recited holding portion, and that the attachment plates 66 and the holes 24 on the flat surface 26 of the speculum 20 correspond with the connecting portion recited in the rejected claims. It is further alleged that the ring 60/61 and the speculum 20 are connected in an adjustable manner as they are removable from one another and that Sher clearly states that the position of the ring 61 can be adjusted relative to the eyelid openers/speculum.

In Sher, a position of the ring 61 relative to the eyelid opener portion 20 and the eyeball is not adjustable while the alleged connecting portion is connected to the holding portion and the eyelid opener portion. As recited in the applied reference, Sher relates to an eye fixation device intended to restrain movement of the eye during ophthalmic procedures (col. 1, lines 5-7). To fix the eye the fixation ring 60 has a plurality of holes on an attachment face that permit a vacuum to be drawn therethrough to secure the ring against the surface of the eye (col. 2, lines 49-56). Sher also discloses a means for fixing the ring 60 with respect to the speculum 20. The speculum includes a pair of flat surfaces 26 having holes 24 disposed on an interface side to contact the attachment plates 66 of the fixation ring 60. When a vacuum is drawn through the holes 24, the ring is held in place on the speculum (col. 2, line 63 - col. 3, line 7). Although Sher discloses that the fixation ring 60 can be adjusted with respect to the speculum (within reasonable limits) without leaving any of the vacuum holes uncovered, it is inherent in the device that the vacuum must be removed from the holes 24 to allow adjustment of the ring on the speculum. Specifically, Sher discloses that the attachment plate 66 is somewhat larger than the field of vacuum holes 24 on the speculum plate 22 so

that the fixation ring can be adjusted within reasonable limits. Were the device adjustable while the vacuum was being drawn, the device would not work for its intended purpose. In other words, if no vacuum was being drawn, the device would not hold the eyeball in place thereby rendering the Sher device useless for its intended purpose.

As DeJuan is merely combined for the teaching of placement of a surgical lens on the surface of the eye, the Office Action does not allege that DeJuan discloses any of the structural features that are not provided by Sher. Furthermore, DeJuan also fails to disclose any of an eyelid opener portion, holding portion or connecting portion as recited in the rejected claims. Thus, withdrawal of the rejection of claims 1, 3, 4 and 6-8 is respectfully requested.

Claims 1, 4 and 5 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,556,417 to Sher (Sher 417) in view of DeJuan. The rejection is respectfully traversed.

It is alleged in the Office Action that Sher 417 also discloses each and every feature recited in the rejected claims. For example, it is alleged in the Office Action that the position between the ring 61, the eyelid openers 22 and the eyeball is adjustable. However, a position of the ring 61 is not adjustable relative to the eyelid opener portion 22 and the eyeball while the connecting portions 44, 42, 40 are connected to the holding portion and the eyelid opener portion. Rather, as stated in Sher 417, "when there is no air pressure differential between the interior and the exterior of the housing the balls are free to rotate within the housing, providing for adjustable orientation of the fixation ring 61. When air pressure is supplied to the housing through the supply tube 46 and in the tube 40 (which is rigidly connected to the speculum arm 28), the balls are urged out into firm sealing contact with the complementary end portions of the housing 36, thereby substantially immobilizing the ring with the speculum 20." Thus, when the connecting portions 44, 42, 40 are connected to the holding portion and

the eyelid opener portion there is no adjustability of the holding portion relative to the eyeball opener portion and the eyeball.

Additionally, when the fixation ring is secured to the eye by actuation of vacuum attached to the vacuum tube 70, the fixation ring is secured to the eyeball. Subsequently when the physician determines that the alignment of the patient's eye with respect to a laser or other instrument is proper, the attachment means between the speculum and the fixation ring is actuated (as by supplying air pressure to the ball valve linkage by actuating a syringe connected to the tube 46, or other suitable means). Then, the fixation ring 61 is thereby secured to the speculum to substantially immobilize the patient's eye for the procedure to be performed (col. 4, lines 24-36). Accordingly, when the elements are connected as recited in the rejected claims, i.e., the vacuum is actuated, there is no adjustability.

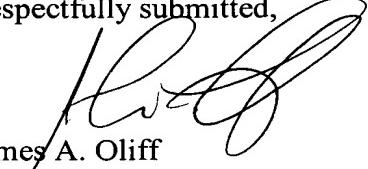
As DeJuan is not alleged to nor does it overcome the deficiencies of Sher 417, the combination of references fails to disclose each and every feature recited in the rejected claims. Accordingly, withdrawal of the rejection of claims 1, 4 and 5 under 35 U.S.C. §103(a) is respectfully requested.

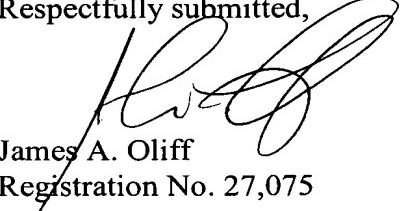
### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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